

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

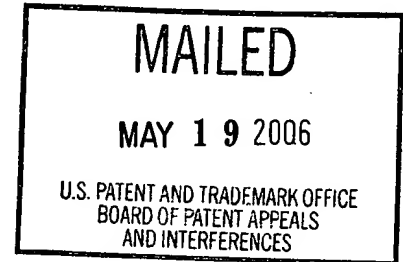
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUTHIRUG N. PISUTHA-ARNOND,
SHEILA R. CROSBY, ERIC CHRISTENSEN,
PAUL SILVER, GEORGE W. SCHAUPP, JR.,
KEITH MCCONNELL and SCOTT E. PREECE

Appeal No. 2006-1379
Application No. 09/504,135

ON BRIEF



Before KRASS, RUGGIERO, and BARRY, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 35, 37-42, and 44-48.

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The invention pertains to a message alert system best illustrated by reference to representative independent claim 35 reproduced as follows:

35. A message alert system for a communication device wherein the communication device comprises a processor and a display for displaying information, comprising:

a computer-readable medium; and

a routine stored in the computer-readable medium and configured for execution by the processor, the routine comprising:

a first routine that receives a message comprising the information;

a second routine that analyzes the message to determine a size thereof, and further analyzes the message to determine whether the message is of a message type for which the third routine is executed;

a third routine that generates a display item for the message in accordance with the size thereof, if the message is of the type for which the third routine is executed.

The examiner relies on the following reference:

Ichikawa et al. (Ichikawa) 4,626,842 Dec. 2, 1986

Claims 35, 37-42, and 44-48 stand rejected under 35 U.S.C.
§ 102(b) as anticipated by Ichikawa.

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Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The examiner contends that all of the elements of claim 35 are disclosed by Ichikawa as follows:

The communication device comprising a processor is indicated by the examiner as being taught as element 4 in Figure 1 and column 2, lines 42-46, where Ichikawa's decoder 4 is disclosed as having a microprocessor-based control unit. The decoder 4 provides for a visual indication of a received message on a per 10-digit basis.

A display element 8 is said to be shown in Figure 1, the display element displaying information.

The system comprises a computer-readable medium, indicated by the examiner to be element 40 in Figure 3 of Ichikawa. A routine stored in the medium is said to comprise a first routine for receiving a message comprising the information (identified by the examiner as being taught at column 3, lines 62-67) and a second routine for analyzing the message to determine a size thereof (identified by the examiner as being taught at column 4, lines 8-32) and further analyzing the message to determine whether the message is of a message type for which the third routine is executed (identified by the examiner as being taught at column 3, line 62 through column 4, line 32). The examiner reads this claim limitation to include the message being limited to 10 digits (see answer-page 4).

The claimed third routine is identified by the examiner as being taught by Ichikawa at column 5, lines 11-57, wherein a display item is generated in accordance with the size thereof if the message is of the type for which the third routine is executed.

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Appellants argue that Ichikawa fails to disclose analyzing the message to determine its size, further analyzing the message to determine whether it is of a message type for which the generating step is executed, and generating a display item for the message in accordance with its size, if the message is of the type for which the generating step is executed.

Since the examiner appears to interpret the size determination of Ichikawa as both a determination of size and a determination of type, appellants argue that the examiner has not identified two different size criteria used by Ichikawa which could be said to anticipate both a determination of "if a generating step is executed" (message type), and if the generating step is executed, a determination as to "how the generating step is executed" (message size) (principal brief-page 5).

Appellants sum up the issue concisely in the reply brief by noting that the primary point of contention is whether in applying Ichikawa to the claims, two different size criteria are necessary in Ichikawa.

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Appellants concur that there is no requirement in the claims for "two different size criteria" but they do contend that the claims require a "type criteria, which is separate from a size criteria" (reply brief-pages 1-2). Therefore, conclude appellants, the examiner's attempt to define a type criteria as corresponding to a size criteria would result in requiring two different size criteria (reply brief-page 2).

We have carefully considered the evidence before us, including the disclosure of Ichikawa, as well as the arguments of appellants and the examiner and we conclude therefrom that the examiner has established a prima facie case of anticipation which has not been successfully rebutted by appellants. Accordingly, we will sustain the rejection of claims 35, 37-42, and 44-48 under 35 U.S.C. § 102(b).

Clearly, Ichikawa describes a routine "that analyzes the message to determine a size thereof," as claimed. Column 4, lines 24-27, describe that it is "necessary to determine whether the received message is less than 10 digits..." It "further analyzes the message to determine whether the message is of a message type for which the third routine is executed," as

claimed, because if the received message is of a "3-word or 4-word length, the Step 125 is executed" (column 5, lines 29-30). The Step 125, described at column 5, lines 31 et seq., is, as claimed, a "third routine that generates a display item for the message" because Step 125 "generates a display" (column 5, lines 33-34) when the message is of the "type" that exceeds 10 digits, i.e., the message must be displayed in 10-digit parts.

Accordingly, this "third routine" described in Ichikawa is also one that generates a display item "in accordance with the size thereof," as claimed, because the routine is executed when the message exceeds 10-digits and must be displayed in portions.

It appears to us that the "size" of the message in Ichikawa may be both a "size" and a criterion for determining a "type" of message. That is, the "type" of message in Ichikawa is one that either is 10-digits or less in length or it is one that is greater than 10-digits in length.

While we understand that appellants intended a different result and that the "type" of message" differed from the "size of that message, we simply do not find such a distinction within the language of the instant claims.

While appellants may contend that the claims require a "type criteria, which is separate from a size criteria," we find nothing in the instant claims which requires the two to be "separate." The claim recites that the second routine "analyzes the message to determine a size thereof, *and further analyzes the message to determine whether the message is of a message type...*" (emphasis added) but this language does not preclude the size of the message from also indicating a "type" of message, as in Ichikawa. It would have been a simple matter for appellants to have amended the claims during prosecution to clearly recite the "type" of message to be separate from, different than, and/or completely independent from the "size" of the message. Some language could have been found to recite what appellants now regard as the distinction over Ichikawa, but, as the claims

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currently stand, we find nothing in the claims that requires us to read the language so narrowly as to read a meaning into the "type" of message that precludes the "type" from specifying a "size" of the message.

At page 2 of the reply brief, appellants argue, in various ways, that the claimed type criteria is "separate" from the claimed "size" criteria, that the examiner's merging of these two constraints is an attempt to satisfy the terms of the claims with a single distinction and that because the instant claims require a distinction based upon message type being treated differently than a distinction in accordance with size, this allegedly precludes the two from being equated to a single distinction.

We disagree since we find no claim language which makes the distinction appellants are attempting to make. Appellants point to no specific claim language that allegedly makes the distinctions argued and we find none.


Accordingly, since we find the instant claim language to be broader than argued by appellants, we will sustain the rejection of claims 35, 37-42, and 44-48 under 35 U.S.C. § 102(b).

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The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED


ERROL A. KRASS)
Administrative Patent Judge)

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge


LANCE LEONARD BARRY
Administrative Patent Judge

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